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BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL TO THE BOARD OF APPEALS

In re Application of: Jim McCollum) Date: January 2, 2004
Serial No.: 09/774,962) Group Art Unit: 3618
Filed: 01/31/01) Examiner: Bottorff, **RECEIVED**
Title: Wheeled, Portable, Collapsible)
Athletic Equipment Carrier)
)

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CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited, in triplicate, with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Terry LAKOS
Name: Terry LAKOS

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APPEALS
REFERENCES

BRIEF ON APPEAL

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

This is an appeal from the Final Rejection, dated September 26, 2003 for the above identified application.

REAL PARTY IN INTEREST

The party(ies) named in the caption of this brief are the real parties of interest in this appeal.

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RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to appellant, appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATEMENT OF AMENDMENTS

There have been no supplemental amendments filed after final rejection.

SUMMARY OF INVENTION

Referring now to the specification, page 7, line 15 through page 12, line 4 and in FIGS. 1-4, a wheeled, portable, collapsible athletic equipment carrier 10 is shown, according to the present invention, comprised of a two-wheeled cart 20 incorporated within an otherwise conventional athletic bag 70 for aiding in the carrying of athletic equipment from one's vehicle to the playing area.

The cart 20 is comprised of a main frame 22 having an anterior end opposite a posterior end. The main frame 22 is preferably constructed of rigid, high-strength aluminum, thereby providing a device being not only lightweight; but high in strength. The main frame 22 includes a hollow, tubular base member 28 forming a U-shape which serves as a base 29 upon which an equipment-filled athletic bag 70 can be supported.

In order to maintain the device in an upright position, a support stand 48 having

an elongated, hollow, cylindrical U-shaped configuration is welded to lower external circumferential sidewalls of the U-shaped portion of the base member 28 at corners 29a, 29b thereof. It is envisioned that the support stand 48 measures approximately 10 inches in width.

A linearly elongated, hollow, tubular base support member 32 is welded perpendicularly at ends between inside external circumferential sidewalls of the posterior end of the main frame 22 so as to provide structural stability thereto.

A hand-operated inflating pump 130 (shown in Figs. 1 and 2) is securely attached to an outer, elongated sidewall of the upright member of the frame 22 in a linear fashion so as to provide a means for inflating basketballs, soccer balls, footballs or other sports balls requiring inflation. The inflating pump 130 includes an air dispensing tube with an inflating stem attached to an end thereof.

An elongated, hollow, tubular handle 36 formed of a U-shape is pivotally mounted to inside external circumferential sidewalls of the main frame 22 at the anterior end thereof. Ends opposite the U-shaped portion of the handle 36 are of an arcuate configuration and extend to their pivotal attachment thereto. The pivotal attachment of the handle 36 to the main frame 22 facilitates a folding action of the handle 36. The handle 36 is folded in a backwards direction toward a rear side of the main frame 22 in an overlapping manner to a flat position, thereby providing a foldable device which is easily transportable.

The U-shaped portion of the handle 36 at the anterior end of the main frame 22 is enclosed within spongy, compressible, rubber material 44 so as to provide user comfort. The rubber material 44 measures approximately 8 inches in length.

The main frame 22 further includes rubber wheels 54 which terminate in a pivotally mounted axle 60a, 60b. To facilitate frictionless rotation of the wheels 54 about their respective pivotally mounted axle 60a, 60b, bearings are mounted at a coupling point of each axle 60a, 60b. It is envisioned that the wheels 54 have a diameter measuring approximately 8 inches so as to provide less initial shock when rolling over uneven terrain, bumps, ruts or other recessions.

Referring now to Figs. 3, an athletic bag 70 for containing athletic equipment is comprised of a generally vertically elongated configuration having a top end 72 opposite a bottom end 74 and is fabricated of a weatherproof, flexible, heavy fabric of nylon or vinyl. The bottom end 74 rests against the base 29 such as to form a bag mounting platform to serve as a base upon which the base 75 of the athletic bag 70 is permanently attached. The base 75 of the athletic bag 70 is permanently attached via a plurality of bolts 123 driven through apertures 121 in the base 75 protruding therethrough and penetrating holes 122 drilled in the bag mounting platform 120 with nuts 123a tightened thereon. A rear side of the athletic bag 70 along a linearly elongated centerline thereof is permanently attached to the brace 40 by a plurality of linearly aligned rivots 128. The athletic bag 70 includes a large opening 80 formed at the top end 72 thereof and is opened and closed with the use of a flap 82 formed at the top end 72 thereof. A wide, linear strip of VELCRO® material 105 is sewn to an underside of the flap 82, and along an outer surface 73 of the top end 72 on a front side of the athletic bag 70, so as to facilitate both the opening and closing of the large opening 80.

A large cavity 85 with a longitudinally extending insert opening 86 is formed on

an outer surface 73 on the front side of the athletic bag 70 between a pair of ball-receiving cylinders 90 (to be describe in greater detail below). The insert opening 86 can be opened and closed with the use of a linearly elongated flap 88 formed along the outer surface 73 of the athletic bag 70. A wide, linear strip of VELCRO® material is sewn to an underside of the flap 88, and along the outer surface of the athletic bag 70, so as to facilitate both the opening and closing of the insert opening 86. It is envisioned that the athletic bag 70 measures approximately 40 inches in length. It is further envisioned that the athletic bag 70 be available in multiple colors for corresponding with team colors.

Each of the pair of ball-receiving cylinders 90 are suitable attached to the front side of the athletic bag 70, and are positioned so as to be on opposed lateral sides of the insert opening 86 of the large cavity 85. The ball-receiving cylinders 90 are fabricated of the weatherproof, flexible, heavy fabric of nylon or vinyl from which the athletic bag 70 is formed. Each ball-receiving cylinder 90 has a measured diameter suitable for accommodating softballs and/or baseballs. The perimeter measurements of each ball-receiving cylinder 90 extends uniformly through the depth thereof. It is envisioned that each ball-receiving cylinder 90 has a length suitable for snugly retaining five softballs therein. However, the length of each ball-receiving cylinder 90 is by no means limiting and is meant only as a suggestion.

An insert opening 96 is formed at a top portion 97 of each ball-receiving cylinder 90, and can be opened and closed with the use of a flap 98 formed at the top portion 97 thereof. A thin, linear strip of VELCRO® material 105 is sewn to an underside of each flap 98, and along an outer surface 99 of the ball-receiving cylinder 90 just below the

insert opening 96 formed therein, so as to facilitate both the opening and closing of the insert opening 96.

The wheeled, portable, collapsible athletic equipment carrier 10 is designed and configured so as to securely accommodate and transport baseballs, softballs, helmets, bats, soccer balls, basketballs, footballs, rackets, protective gear, and other similar athletic equipment to a playing area. In addition, being collapsible in design with respect to the folding handle 36, and the rotating wheels 54, the wheeled, portable, collapsible athletic equipment carrier 10 allows for the neat, orderly storage and transportation thereof within the trunk of a vehicle.

ISSUES

The examiner rejected Claim 1 as being unpatentable under 35 U.S.C. 102(b) as being anticipated by Fox, and rejected Claims 1, 2, 5 and 7 under 35 U.S.C. 102(b) as being unpatentable over Server Perez. Further, Claim 3 was rejected as being unpatentable under 35 U.S.C. 103(a) as being unpatentable over Server Perez in view of Weldon, and rejected claim 4 under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Green as well as Server Perez in view of Green and rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Pratt et al. as well as Server Perez in view of Inge.

Therefore, the issues on appeals are:

1. Is Claim 1 anticipated under 35 U.S.C. 102(b) by Fox?
2. Are Claims 1, 2, 5 and 7 anticipated under 35 U.S.C. 102(b) by Server

Perez?

3. Is claim 3 anticipated under 35 U.S.C. 103(a) by Server Perez in view of Weldon?
4. Is claim 4 anticipated under 35 U.S.C. 103(a) by Allen in view of Green as well as Server Perez in view of Green?
5. Is claim 8 anticipated under 35 U.S.C. 103(a) by Allen in view of Pratt et al. as well as Server Perez in view of Inge?

GROUPING OF CLAIMS

Claim 6 forms a first group of claims; Claims 1-3 and 5-7 form a second group of claims; claim 4 forms a third group of claims; and claim 8 forms a fourth group of claims. Each group stands or falls separate from one another.

ARGUMENT

1. Rejections under 35 U.S.C. 102(b)

The examiner rejected Claim 1 as being unpatentable under 35 U.S.C. 102(b) as being anticipated by Fox, and rejected Claims 1, 2, 5 and 7 under 35 U.S.C. 102(b) as being unpatentable over Server Perez.

In undertaking to determine whether one reference anticipates another under 35 U.S.C. 102(b), a primary tenet is that the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Many differences exist. To briefly summarize the distinguishing features and characteristics of each, Fox teaches an a wheeled cart specifically adapted for supporting and transporting a bowling ball bag, and Server Perez discloses a foldable cart for shopping.

However, unlike the present invention, both references fail to *claim* an athletic bag incorporating a *cart*.

Therefore, in light of the numerous differences between Fox and Server Perez the present invention, the examiner's rejection of Claims 1, 2, 5 and 7 under 35 U.S.C. 102(b) is inappropriate.

2. Rejections under 35 U.S.C. 103(a)

The examiner rejected Claim 3 was rejected as being unpatentable under 35 U.S.C. 103(a) as being unpatentable over Server Perez in view of Weldon, and rejected claim 4 under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Green as well as Server Perez in view of Green and rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Pratt et al. as well as Server Perez in view of Inge.

The differences with respect to Fox and Server Perez have been stated above.

Weldon teaches a portable cooler caddy which includes a cup holder panel.

However, unlike the present invention, Weldon fails to teach an athletic bag, and

hence also fails to teach an athletic bag with a bottom end permanently attached to the base member of the main frame.

In addition, unlike the present invention, Weldon fails to teach an inflating pump attached to an upright member of the main frame.

Examiner argues it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach a hand-operated inflating pump to the main frame.

However, in light of the failure by each of the aforementioned references to disclose the attachment of such inflating pump to an athletic carrier as taught by the present invention, the attachment of such component is nonobvious.

Pratt et al. teaches a golf ball holder mountable to a golf bag, golf cart, belt, or the like.

Green teaches a back carried apparatus for storing and carrying golf balls, in combination with a wand to pick up golf balls while walking along. It specifically claims a pair of parallelly spaced frames having a spring urging means for clamping the frames around the golf balls. No cylinder is included, among other very numerous differences with the present invention.

Allen teaches an athletic bag for carrying, storing and airing out athletic equipment. However, Allen fails to *claim* a two-wheeled cart. In contrast, Allen merely *claims wheel members* in Claim 11, thus failing to claim specifically a *two-wheeled cart*.

In addition, unlike the present invention, Allen fails to *claim* an athletic bag incorporating a *cart*.

Furthermore, in contrast to the present invention, Allen fails to *claim* an athletic

bag fabricated of a *weatherproof, flexible, heavy fabric*. Allen, rather, claims a *common fabric*, a *fabric enclosure*, and a *fabric enclosure member*, as stated in claims 7, 8, and 13 respectively.

However, based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103(a), in addition to any other art, relevant or not, is also inappropriate.

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103, in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument application wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to

describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

Further, in rejecting claims under 35 U.S.C. 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. 1993) A prima facie case of obviousness is established by presenting **evidence** that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Although many sources of suggestion are allowed, this requirement for actual evidence must be met with a clear and particular showing. See, e.g. C.R. Bard Inc. v. M3 Sys., Inc. 1527 F.3d 1340, 1352, 48 USPQ2d 1255, 1232 (Fed. Circ. 1998). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ 1614, 1617 (Fed. Cir.

1999).

To summarize, it appears that the examiner is holding us to a much different standard of obviousness than any of the other patent applications that have been cited as the relevant art. only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, the examiner's rejection of claims 1-8 under 35 U.S.C. 103(a) on obviousness grounds was improper. Most importantly there is no suggestion in any of the references for the combination proposed. If a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. Orthopedic Equipment, supra.

Accordingly, the reversal of the Examiner by the honorable Board of Appeals is respectfully solicited.

Respectfully submitted,
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APPENDIX

THE CLAIMS ON APPEAL

The claims on appeal are as follows:

1. A wheeled, portable, collapsible athletic equipment carrier comprising:
 - a two-wheeled cart; and
 - an athletic bag incorporating said cart for aiding in the carrying of athletic equipment from one's vehicle to the playing area.
2. The equipment carrier of Claim 1, wherein said cart comprises:
 - a main frame having an anterior end opposite a posterior end and including a hollow, tubular base member forming a U-shape which serves as a base upon which said athletic bag can be supported.
- 3.(Once Amended) The equipment carrier of Claim 2, wherein said cart further comprises:
 - a support stand having an elongated, hollow, cylindrical U-shaped configuration affixed to lower external circumferential sidewalls of said U-shaped portion of said base member at corners so as to provide structural stability thereto.
- 4.(Once Amended) The equipment carrier of Claim 1, further comprising a hand-operated inflating pump securely attached to an outer, elongated sidewall of an upright member of said main frame in a linear fashion so as to provide a means for inflating

sports balls requiring inflation.

5.(Once Amended) The equipment carrier of Claim 2, wherein said cart further comprises an elongated, hollow, tubular handle formed of a U-shape and pivotally mounted to inside external circumferential sidewalls of said main frame at said anterior end thereof.

6. The equipment carrier of Claim 1, wherein said athletic bag comprises a generally vertically elongated configuration having a top end opposite a bottom end and is fabricated of a weatherproof, flexible, heavy fabric.

7.(Once Amended) The equipment carrier of Claim 1, wherein said bottom end of said athletic bag rests against said base member such as to form a bag mounting platform to serve as a base upon which a base of said athletic bag is permanently attached.

8. The equipment carrier of Claim 1, further comprising a pair of ball-receiving cylinders attached to the front side of the athletic bag, each said ball-receiving cylinder has a measured diameter suitable for accommodating softballs and/or baseballs.